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20350 7590 02/04/2009 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER				
FIELDS, BENJAMIN S				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/714,441

**Applicant(s)**

GRAVETT ET AL.

**Examiner**

BENJAMIN S. FIELDS

**Art Unit**

3692

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. Upon further review of the arguments provided by the applicant in the Pre-Appeal Brief filed 6 November 2008, the FINAL Office Action mailed 18 September 2008 has been withdrawn. The prosecution of this application is hereby reopened.

2. The following is a **NON-FINAL** Office Action in response to the communication received on 6 November 2008. Claims 1-20 are now pending in this application.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims **1**, **8**, and **15** are rejected under 35 U.S.C. 101 because the claimed invention is not directed to a secondary statutory subject matter/class.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. In this particular case, Claims **1**, **8**, and **15** are not tied to another statutory class, such as any hardware. Thus, it is unclear as to whether or not the claims are mere processes that involve purely human labor.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.: [http://iplaw.bna.com/iplw/5000/split\\_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neofytides et al. (US PG Pub. No. 2002/0152168), [hereinafter Neofytides] in view of Katz (US PG Pub. No. 2002/0013767), [hereinafter Katz].

Referring to Claim 1: Neofytides shows a method for creating an open network stored account (Neofytides: Abstract; Page 3, Paragraph 0045; Page 4, Paragraph 0056; Page 5, Paragraph 0066; Page 6, Paragraph 0072) by a purchaser, the method comprising steps of: receiving at an intermediate system, a first message to create the stored benefit account, the first message including a purchaser account identifier (Neofytides: Abstract; Figure 5a, Figure 11b; Page 3, Paragraph 0045; Page 4, Paragraph 0056; Page 5, Paragraphs 0066-0067//Neofytides teaches a system where a user must log in via usage of account information//), the purchaser account identifier identifying a purchaser account, wherein the purchaser account identifier and other account information is entered by a purchaser with a web interface to create the stored benefit account (Neofytides: Page 2, Paragraph 0025//Neofytides discusses a system where interaction amongst all parties occurs via a web [internet] interface//); the intermediate system processing the first message that is received with an application interface of a credit processing system (Neofytides: Page 2, Paragraph 0025; Figure 5a//Neofytides shows a credit system which communicates via an application interface through the internet//), wherein the purchaser account is used to fund the open

network stored benefit account (Neofytides: Page 1, Paragraph 0021-0022//Neofytides discloses a stored fund value account system and method which is accessed by means of an account identifier//); the intermediate system receiving a first message response with the application interface, wherein the intermediate system determines if the first message response is consistent with the other account information received from the purchaser in the first message, wherein the intermediate system determines from the first message response (Neofytides: Page 2, Paragraph 0024-0026//Neofytide shows interfaces which verify, check, and maintain consistency throughout the system//), if the purchaser account associated with the purchaser account identifier can validly fund the stored benefit account (Neofytides: Page 6, Paragraph 0071-0073//Neofytides details a system which verifies funds are available within the process in order for transaction completion//); the intermediate system receiving a second message response with the application interface; the intermediate system processing the second message response (Neofytides: Figure 5// Neofytides allows multiple transaction account messages to take place across the interfaces available//), wherein: the second message includes recipient account information (Neofytides: Figure 5//Neofytides shows interfaces which contain account information//), the stored account is created with the recipient account information (Neofytides: Figure 5; Page 1, Paragraph 0021; Page 3, Paragraph 0045; Page 4, Paragraph 0056; Page 5, Paragraph 0066; Page 6, Paragraph 0072)//Neofytides discloses a system for stored value fund accounts which contain account information//), the stored benefit account is backed by an account issuer, the stored benefit account is accepted by a network of unrelated merchants who

accept payments from the account issuer (Neofytides: Figures 5-6) and providing the stored benefit account to the recipient for the recipient's use (Neofytides: Figure 5; Page 1, Paragraph 0021; Page 3, Paragraph 0045; Page 4, Paragraph 0056; Page 5, Paragraphs 0066-0067; Page 6, Paragraph 0072).

Neofytides, however, does not expressly utilize the terms "create" in relation to the opening of the network stored account; and "intermediate" in relation to receiving at an intermediate system a first message to create the open network stored benefit account the first message including a purchaser account identifiers the purchaser account identifier identifying a purchaser account wherein the purchaser account identifier and other account information is entered by a purchaser with a web interface to create the stored benefit account; the intermediate system determines from the first message response if the purchaser account associated with the purchaser account identifier can validly fund the stored benefit account; the intermediate system receiving a second message response with the application interface; the intermediate system processing the second message response wherein: second message response includes recipient account information the stored benefit account is created with the recipient account information.

Katz, in a similar environment, discloses usage of the terms "create" in relation to the opening of the network stored account ; and "intermediate" in relation to receiving at an intermediate system a first message to create the open network stored benefit account the first message including a purchaser account identifiers the purchaser account identifier identifying a purchaser account wherein the purchaser account

identifier and other account information is entered by a purchaser with a web interface to create the stored benefit account (Katz: Page 1, Paragraph 0007; Page 2, Paragraphs 0020-0022); the intermediate system determines from the first message response if the purchaser account associated with the purchaser account identifier can validly fund the stored benefit account (Katz: Figure 1; Claims 1, 6); the intermediate system receiving a second message response with the application interface (Katz: Figure 1; Page 1, Paragraph 0007; Page 2, Paragraphs 0020-0022); the intermediate system processing the second message response wherein: second message response includes recipient account information the stored benefit account is created with the recipient account information (Katz: Figure 1; Page 1, Paragraph 0007; Page 2, Paragraphs 0020-0022; Claims 1, 6).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the teaching of Neofytides for an automated transfer with stored value fund with the features of Katz for an electronic funds transfer system for financial transactions to include the creation of a stored benefit account with intermediary functionality for the purpose of allowing manual interaction of money transfers to and from a stored value fund (Neofytides: Page 1, Paragraph 0004).

Referring to Claim 2: Neofytides teaches the method for creating the open network stored account comprising a step of processing formatted commands with the application interface (Neofytides: Figure 5-11//Neofytides depicts, by means of a series of flowcharts, and within disclosure, that executable commands are utilized to perform the main inventive concept//).



Referring to Claim 3: Neofytides discloses the method for creating the open network stored benefit account by the purchaser for the benefit of the recipient wherein the second message is not sent to the application interface if it is determined that the purchaser account cannot validly fund the stored benefit account (Neofytides: Figure 8// Neofytides displays system wherein checks and maintenance of sufficient funding is thoroughly completed//).

Referring to Claim 4: Neofytides teaches a method for creating the open network stored benefit account by the purchaser for the benefit of the recipient, further comprising a step of sending a stored value card to the recipient for use with the stored benefit account (Neofytides: Figure 5a//Neofytides teaches a delivery of negotiable instruments being sent (i.e. cards, etc. to the payee//)).

Referring to Claim 5: Neofytides shows a method for creating the open network stored benefit account by the purchaser for the benefit of the recipient, further comprising a step of e-mailing the recipient with notification relating to creation of the stored benefit account (Neofytides: Figure 7//Neofytides shows that creation of an account using such system involves contact via electronic mail (e-mail//)).

Referring to Claim 6: Neofytides teaches a method for creating the open network stored benefit account by the purchaser for the benefit of the recipient, wherein the stored benefit account supports both stored value payments and credit payments to the network (Neofytides: Paragraph 0004, 0020-0022// Neofytides shows various types of value and/or credit payments are utilized//).

Referring to Claim 7: Neofytides discusses a method for creating the open network stored benefit account by the purchaser, further comprising steps of: determining if the account issuer of the purchaser account is supported by the credit processing system (Neofytides: Page 1, Paragraph 0021-0023; Figure 5//Neofytides describes a method which allows a user to authenticate, establish, and utilize the system, hence, the user account must be compatible or supported by the system//); and opening the stored benefit account with an alternative credit processing system where the account issuer is determined to be unsupported by the credit processing system (Neofytides: Figures 5-6//Neofytides shows, that if the user may not be supported by the system, allowance to make such changes can be made/adjusted//).

Referring to Claim 8: Claim 8 parallels the limitations of Claim 1. As such, Claim 8 is rejected under the same basis as is Claim 1 as indicated supra.

Referring to Claim 9: Claim 9 reflects the limitations of Claim 2. As such, Claim 9 is rejected under the same basis as is Claim 2 as indicated supra.

Referring to Claim 10: Neofytides discloses a method for creating the open network stored benefit account by the payor for the benefit of the payee wherein the second message is not sent to the application interface if it is determined that the payor account cannot validly fund the stored benefit account (Neofytides: Figure 8//Neofytides displays system wherein checks and maintenance of sufficient funding is thoroughly completed//).

Referring to Claim 11: Neofytides shows a method for creating the open network stored benefit account by the payor for the benefit of the payee, further comprising a

step of sending a stored value card to the payee for use with the stored benefit account (Neofytides: Figure 5a//Neofytides teaches a delivery of negotiable instruments being sent (i.e. cards, etc. to the payee//)).

Referring to Claim 12: Neofytides shows a method for creating the open network stored benefit account by the payor for the benefit of the payee, further comprising a step of e-mailing the payee with notification relating to creation of the stored benefit account (Neofytides: Figure 7//Neofytides shows that creation of an account using such system involves contact via electronic mail (e-mail//)).

Referring to Claim 13: Claim 13 parallels the limitations of Claim 6. As such, Claim 13 is rejected under the same basis as is Claim 6 as indicated supra.

Referring to Claim 14: Neofytides teaches a method for creating the open network stored benefit account by the payor for the benefit of the payee, further comprising steps of: determining if the account issuer of the payor account is supported by the credit processing system (Neofytides: Figure 5a//Neofytides displays a method wherein the user is supported by the system//); and opening the stored benefit account with an alternative credit processing system where the account issuer is determined to be unsupported by the credit processing system (Neofytides: Figure 5a//Neofytides displays a method wherein the user may not be supported by the system, and can, however, achieve access//).

Referring to Claim 15: Claim 15 reflects the limitations of Claim 1. As such, Claim 15 is rejected under the same basis as is Claim 1 as mentioned supra.

Referring to Claim 16: Claim 16 parallels the limitations of Claim 2. As such, Claim 16 is rejected under the same basis as is Claim 2 as mentioned supra.

Referring to Claim 17: Neofytides discloses a method for creating the open network stored benefit account by the payor for the benefit of the payee wherein the second message is not sent to the application interface if it is determined that the payor account cannot validly fund the stored benefit account (Neofytides: Figure 8//Neofytides displays system wherein checks and maintenance of sufficient funding is thoroughly completed – Until sufficient funding is achieved completion of the transaction can not take place//).

Referring to Claim 18: Neofytides shows a method for creating the open network stored benefit account by the payor for the benefit of the payee, further comprising a step of sending a stored value card to the payee for use with the stored benefit account (Neofytides: Figure 5a//Neofytides teaches a delivery of negotiable instruments being sent (i.e. cards, etc. to the payee//)).

Referring to Claim 19: Neofytides discloses a method for creating the open network stored benefit account by the payor for the benefit of the payee, further comprising a step of e-mailing the payee with notification relating to creation of the stored benefit account (Neofytides: Figure 7//Neofytides shows that creation of an account using such system involves contact via electronic mail (e-mail//)).

Referring to Claim 20: Claim 20 reflects the limitations of Claim 6. As such, Claim 20 is rejected under the same basis as is Claim 6 as mentioned supra.

***Response to Arguments***

7. Applicants arguments filed 6 November 2008 have been fully considered but have been found to be **moot** and **non-persuasive** in view of the new grounds of rejection.

**Examiner Note**

8. **The Examiner has pointed out particular reference(s) contained in the prior art of** record within the body of this action for convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. **Applicant**, in preparing the response, should **fully consider the entire reference** as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Conclusion***

9. Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached MONDAY THRU FRI between the hours of 9AM and 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KAMBIZ ABDI can be reached at 571.272.6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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30 January 2009

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